



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : van Lengerich
Serial No. : 09/233,443 Group Art Unit: 1761
Filed : January 20, 1999 Examiner: Mr. Edward Webman
For : ENCAPSULATION OF SENSITIVE LIQUID COMPONENTS
INTO A MATRIX TO OBTAIN DISCRETE SHELF-STABLE
PARTICLES

ELECTION AND RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

Responsive to the January 19, 2001 election and restriction requirement, the applicant hereby elects the invention of Group I, claims 21-27, 29, 47-60, 66 and 67, the durum wheat plasticizable matrix species and the microorganism/neutraceutical compounds species, **with traverse**. Applicant believes that claims 21-22, 25-29, 46-64 and 66-67 are readable upon the durum wheat plasticizable matrix species. Applicant further believes that claims 21-24, 26, 29, 46-57, 59, and 61-67 are readable on the microorganism neutraceutical compounds species. It is believed that claims 21-22, 26, 29, 46-57, 59, 61-64, and 66-67 are readable on both the durum wheat plasticizable matrix species and the microorganism neutraceutical species.

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Response to Restriction Requirement

The Examiner states that the "Inventions of I and II are related as *mutually exclusive species* in an intermediate-final product relationship." (emphasis supplied)

This statement is the very first sentence of the Examiner's reasons supporting distinctness and it is, on its face, clearly incorrect. *The two groups of claims do not define mutually exclusive species.* The mutually exclusive species requirement is contained in the first sentence of the form paragraph 8.14 used by the Examiner, and it is clearly set forth in the very first paragraph following and explaining form paragraph 8.14 in the MPEP. Please see MPEP § 806.04(b), first full paragraph following form paragraph 8.14. In the definition of a "mutually exclusive species relationship," there must always be an element recited in the first group or "intermediate" product claims which is ~~not~~ found in the second group or "final product" claims; and there must always be an element found in the second group or "final product" claims which is disclosed by the specification only for the second group of claims and not for the first group of claims. MPEP 806.04(f).

The "mutually exclusive species" test is definitional and is not met in this case. Applying the test to the instant claims, there is no element exclusive to the intermediate product: Groups I and II of the instant claims each recite limitations to the same encapsulant, the same plasticizable matrix, the same liquid plasticizer component, the same component for controlling the release rate of the encapsulant, and the same

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encapsulated product; and there is no element exclusive to Group I of the claims, meaning that every element of Group I is also contained in the claims of Group II.

The Examiner has put Claim 29, a food topping product containing the encapsulated product of Group I, with the claims of Group I. However, a food topping is not an intermediate product, here, it is a final product. If there really is sufficient exclusivity between the products of Group I and of Group II to justify the restriction requirement, then why has the Examiner included Claim 29 in Group I?

In a telephonic interview that occurred September 07, 2000 between Examiner Webman and Mr. Andrew Merriam, Representing Applicants, Mr. Merriam pointed out how in the instant case the intermediate-final product restriction requirement fails to define two products that are mutually exclusive species, and that restriction between the two groups of the instant claims is improperly based on the intermediate-final product relationship. The Examiner responded only by stating that other products aside from food products fall within the scope of the present claims. The Examiner's response goes to the question of distinctness and not to the question of mutual exclusivity. The Examiner agreed to reconsider the restriction requirement.

Applicant respectfully requests the reconsideration and withdrawal of the January 19, 2001 restriction requirement.

The applicant traverses all of the requirements for an election of species because the searches are coextensive. Thus, withdrawal of the species election requirements

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should not impose a serious burden on the Examiner versus a complete search of any one set of species, and applicant believes that such election requirements should be withdrawn. See MPEP § 803.

Reconsideration and withdrawal of the January 19, 2001 election requirement is respectfully requested.

Submitted concurrently herewith is a petition requesting a one-month extension and the accompanying fee of \$110.00 to maintain the pendency of the instant file.

If any additional fees are due, please charge our Deposit Account No. 50-1032.


Respectfully submitted,



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March 19, 2001

<p align="center">CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence dated <u>3/19/01</u> is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on <u>3/19/01</u>.</p> <p align="right"> HOLLANDER LAW FIRM, P.L.C. Suite 305 10300 Eaton Place Fairfax, Virginia 22030</p> <p>Date: <u>3/19/01</u></p>
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